

## **REMARKS**

Applicant has received and carefully reviewed the Final Office Action of the Examiner mailed November 21, 2008. Currently, claims 1-15, 17-19 and 22-26 are pending, wherein claims 1-15, 17-19 and 23-26 have been rejected. With this paper, claims 1, 11, 12, 17, and 23 have been amended. Support for the amendments may be found in the specification, claims, and drawings as originally filed. No new matter has been added. Favorable consideration of the following remarks is respectfully requested.

### **Rejections under 35 U.S.C. § 102**

Claims 1-2, 4-9, 11-15, 17-18 and 23-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fischell et al. (US 5,484,425). Applicant respectfully traverses this rejection.

Independent claim 1, as amended, recites:

1. A medical device, comprising:
  - a tubular member having a proximal end region and a distal end region;
  - a radiopaque marker band disposed over the tubular member, the marker band having an outer surface and an inner surface with one or more openings through the outer surface of the marker band; and
  - an outer layer disposed over the outer surface of the marker band, wherein the outer layer extends from the outer surface of the marker band into the openings in the marker band, completely fills the openings, and is at least partially disposed between the tubular member and the inner surface of the radiopaque marker.

Fischell et al. do not teach such a device. For example, Fischell et al. do not teach or suggest a radiopaque marker band with one or more openings through the outer surface. Further, Fischell et al. do not teach or suggest an outer layer is disposed over the outer surface of the marker band, completely fills the openings, and is at least partially disposed between the tubular member and the inner surface of the radiopaque marker. MPEP 2131 states, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Fischell et al. teach a non-kinking, thin walled introducer sheath. The introducer sheath has an inner helically wound metal coil and a plastic cover disposed over the metal coil. In response to Applicant's previous arguments, the Examiner asserts, "The examiner disagrees and maintains that one of ordinary skill in the art would recognize that one way of achieving a coil is by cutting a tubular member. Therefore, the examiner maintains that the slits between the coils of Fischell can be interpreted as opening through the outer surface of the marker band." While Applicant does not agree with the Examiner's interpretation, in the interest of further prosecution, the claim has been amended to include the limitation, "an outer layer... is at least partially disposed between the tubular member and the inner surface of the radiopaque marker." Fischell et al. do not teach or suggest the plastic cover is disposed between a tubular member and an inner surface of the helical coil and thus cannot be considered as anticipating the claimed device. Further, there is no motivation, suggestion, or other reason for one of ordinary skill in the art to modify the device of Fischell et al. to arrive at the present device. Reconsideration and withdrawal of the rejection are respectfully requested. For similar reasons and others, Applicant submits that claims 2 and 4-9 are also in condition for allowance as they depend from claim 1 and they add significant limitations to further distinguish them from the prior art.

Independent claims 11, 12 and 23 have been similarly amended. For at least the reasons discussed above, Fischell et al. do not teach each and every element of independent claims 11, 12, and 23 or the claims dependent thereon. Further, there is no motivation, suggestion, or other reason for one of ordinary skill in the art to modify the device of Fischell et al. to arrive at the present device. Reconsideration and withdrawal of the rejection are respectfully requested.

Independent claim 17, as amended, recites:

17. A radiopaque marker band adapted for being secured to an intravascular medical device, comprising:

a generally cylindrical body section having a first end surface, a second end surface and an annular wall extending from the first end surface to the second end surface, the body section having a first hole and a second hole defined therein;

wherein the first hole and the second hole are axially aligned on opposing sides of body section; and

wherein the body section includes one or more longitudinal slits, the one or more slits extending from the first end surface of the generally cylindrical body toward the second end surface of the generally cylindrical body.

Fischell et al. do not teach or suggest such a device. For example, Fischell et al. do not teach or suggest a radiopaque marker band wherein the body section includes one or more longitudinal slits, the one the one or more slits extending from the first end surface of the generally cylindrical body toward the second end surface of the generally cylindrical body. As discussed above, Fischell et al. teach a helically wound coil. The Examiner asserts the windings of a coil can be interpreted as holes. However, if one were to interpret a coil as the Examiner has (which Applicant does not concede as correct), one would have helical openings. Fischell et al. do not teach or suggest one or more longitudinal slits, the one or more slits extending from the first end surface of the generally cylindrical body toward the second end surface of the generally cylindrical body as currently claimed. Thus Fischell et al. cannot be considered as anticipating the claimed device. Further, there is no motivation, suggestion, or other reason for one of ordinary skill in the art to modify the device of Fischell et al. to arrive at the present device. Reconsideration and withdrawal of the rejection are respectfully requested. For similar reasons and others, Applicant submits that claims 18 and 26 are also in condition for allowance as they depend from claim 17 and they add significant limitations to further distinguish them from the prior art.

**Rejections under 35 U.S.C. § 103**

Claims 3, 10 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fischell et al. Applicant respectfully traverses this rejection.

Claims 1 and 17, from which claims 3, 10 and 19 depend, are distinguished above as being patentable over Fischell et al. At least because they depend from one of claims 1 and 17 and add significant limitations to further distinguish them from the prior art, Applicant respectfully submits that claims 3, 10 and 19 are allowable over the cited reference. Reconsideration and withdrawal of the rejection is respectfully requested.

**Conclusion**

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,  
Richard C. Gunderson  
By his Attorney,

Date: December 31, 2008

/david m. crompton/  
David M. Crompton, Reg. No. 36,772  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349